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PATENT
450100-04723
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Kazushi WADA et al.
Serial No. : 10/521,587
For : SOLID-STATE IMAGE PICKUP DEVICE AND MANUFACTURING METHOD THEREOF
Filed : February 10, 2005
Examiner : Thanh Y. Tran
Art Unit : 2822

745 Fifth Avenue
New York, NY 10151
Tel: 212-588-0800

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☒ No additional fee is required.
☐ The fee has been calculated as shown below.
☐ This is an application of a small entity under 37 CFR 1.9(f), and the amounts shown in parentheses apply.

Claims as Amended

(1)	(2) Claims remaining after amendment	(3)	(4) Highest number previously paid for	(5) Present extra	(6) Rate	(7) Additional Fee
Total claims	17	Minus	** = 30	*0x	\$50 (25)	=\$0
Independent claims	3	Minus	*** = 3	*0x	\$200 (100)	=\$0
Total additional fee for this amendment						\$0

- * If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.
** If the highest number of total claims previously paid for is less than 20, write "20" in this space.
*** If the highest number of independent claims previously paid for is less than 3, write "3" in this space.

- ☐ This application contains a multiple dependent claim. The required fee of \$360(180) has been previously paid ☐, or is paid herewith ☐.
- ☒ This response is being filed within the first month following the expiration of the term originally set therefore. This is a petition to request a one-month extension of time. A check covering the cost of the petition is enclosed.
- ☒ A check in the amount of \$ 120.00 is attached, which covers the cost of ☐ additional claims ☒ petition for extension of time.
- ☐ Charge \$ ___ to Deposit Account No. 50-0320.
- ☒ Please charge any additional fees incurred by reason of this response or credit any overpayment to Deposit Account No. 50-0320.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 13, 2006.**

William S. Frommer, Reg. No. 25,506

Name of Applicant, Assignee or Registered Representative


Signature


September 13, 2006

Date of Signature

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By:


William S. Frommer
Reg. No. 25506
Tel: 212-588-0800

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450100-04723

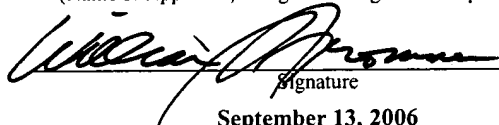
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William S. Frommer, Reg. No. 25,506
(Name of Applicant, Assignee or Registered Representative)



Signature
September 13, 2006

Date of Signature

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop **Amendment**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated July 14, 2006, the term for replying thereto being extended for one month to September 14, 2006, wherein restriction was required among the claims as follows:

Group I, claims 1-13, characterized by the Examiner as being “drawn to a solid-state image pickup device;” and

Group II, claims 14-17, characterized by the Examiner as being “drawn to a method of manufacturing a solid-state image pickup device.”

Applicants elect, with traverse, Group I claims 1-13.

The Examiner justified his requirement of restriction between the claims of Group I and the claims of Group II by stating:

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The invention Group I does not require to include the process of forming one or a plurality of impurity regions in a lower layer of the transfer portion in the substrate. (Emphasis the Examiner's.)

It is appreciated, this application is a national phase application, filed under 35 USC 371, based on International Application PCT/JP03/10217. It must be pointed out that the international application was not subjected to a restriction requirement. That is, contrary to the position taken here by the Examiner, it was found during the examination of the international application that the claims of Groups I and II relate to the same, single general inventive concept. Reference is made to MPEP §1893.03(d), which states, in pertinent part:

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also the examples contained in Chapter 10 of the International Search and

Preliminary Examination Guidelines which can be obtained from WIPO's web site.

A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.

Here, claim 14 of Group II includes the very same language that is used in, for example, claim 3 of Group I. Claim 14 recites the step of forming one or a plurality of impurity regions on a lower layer of the transfer portion in the substrate and this is recited in claim 3. Thus, the process of claim 14 results in the product of claim 3.

Consistent with MPEP § 1893.03(d), the claims of Group II should be examined along with the claims of Group I; and the instant restriction requirement should be withdrawn.

Furthermore, it is submitted that a search for the invention defined by the Group I claims will require a search that encompasses the claims of Group II. After all, to search the image pickup device of claim 3 (made by the method of claim 14) inherently requires that the method of claim 14 be searched. Therefore, if the present requirement for restriction between the claims of Groups I and II is maintained, the logical result will be the filing of a divisional application to include the claims encompassed by the non-elected group. Of course, this will mean that the examination of such claims will be delayed. However, since the search for the claims included in the divisional application will overlap with and, in all probability, be identical to the search that is to be conducted on the Group I claims elected herein, the primary effort needed to examine all applications will be repeated. Furthermore, it is likely that the same Examiner will be in charge of the divisional case; but in light of the delay between the prosecution of the present application and that of the divisional application, the Examiner will have to conduct a

duplicate, redundant search at a later time. Alternatively, if a different Examiner is assigned to the divisional application, a significant loss of PTO efficiency will result in his examination of that divisional case. After all, the present Examiner will be the individual in the best position to examine all applications and he will be fully familiar with the subject matter of that divisional application.

Therefore, since the only logical outcome of the present restriction requirement between the claims of Group I and the claims of Group II would be to delay the examination of the claims included in Group II, resulting in inefficiencies on the part of the Office and unnecessary expenditures by Applicants, and since the single search can be done for all claims without any significant burden on the Office, the withdrawal of the instant requirement of restriction between claims 1-13 on the one hand and claim 14-17 on the other, and the examination on the merits of all of claims 1-17 are respectfully solicited.

The Examiner also took the position that the claims of Group I cover two species which he characterized as follows:


Species I in which the potential under the transfer portion is smaller than the potential under the photosensor portion along the depth direction of the substrate in a range from the minimum potential position to the overflow barrier (claims 1-11); and

Species II in which the potential in the overflow barrier under the transfer portion is smaller than the potential in the overflow barrier under the photosensor portion (claims 12-13).

Applicants elect, **without traverse**, those claims that read on Species I, namely, claims 1-11. It is submitted that, should the "restriction requirement" be withdrawn, as it should be, this requirement for an election of species likewise will be withdrawn.

Accordingly, an action on the merits of all claims, and at least claims 1-11 and 14-17 is solicited.

Respectfully submitted,
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